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**Remarks**

Claims 1-9 are pending in the application. Claims 1 and 8 have been amended to clarify that the claimed sound dampening pad is in the form of a strip material having a finite length. Basis for the amendment may be found in the specification at page 6, paragraph [0025]. No new matter has been entered.

Claims 1-9 were rejected as being obvious under § 103(a) in light of Mahl (US 3,998,347) and Caldwell (US 3,160,549). Applicants respectfully traverse this rejection.

To establish a prima facie case of obviousness, three basic criteria must be met. MPEP 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *Id.* Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *Id.*

Claim 1 recites, *inter alia*, a sound dampening pad comprising a strip of flexible polymeric material having a finite length, and a generally curved J-shaped configuration when viewed from an end thereof. The sound dampening pad further comprises inner and outer surfaces, wherein the inner surface comprises the inner radius of the J-shaped configuration, and the outer surface comprises the outer radius of the J-shaped configuration. The inner surface further comprises a pressure sensitive adhesive thereon. The sound dampening pad is operable to dampen sound by mounting the sound dampening pad on at least one end of a cylindrical sleeve. Similarly, claim 8 recites, *inter alia*, a sound dampening pad having a finite length and a generally curved configuration.

Mahl is cited for teaching an elastomeric ring 22 comprising a flexible polymeric material with a J-shaped configuration. Mahl is also cited for teaching that the ring has an inner

surface comprising an inner radius, and an outer surface comprising an outer radius. The examiner concedes that Mahl fails to teach a pressure sensitive adhesive located on the inner surface of outer leg 24 of ring 22.

To cure this noted deficiency, the examiner adds the pressure sensitive adhesive of the Caldwell sound dampening member to the arrangement of Mahl. The examiner asserts it would have been obvious to make the combination, because the adhesive would provide ready-to-lay convenience to the Mahl arrangement.

Mahl, singularly or in combination with Caldwell, fails to teach all elements of independent claims 1 and 8. First, Mahl teaches a seal for bell jar, rather than a sound dampening pad, as recited in the claims. Furthermore, there is no teaching or suggestion that the Mahl seal facilitates sound dampening. As stated in MPEP 2143, the teaching or suggestion to modify and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re *Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP 2143. "One cannot base obviousness upon what a person skilled in the art might try or might find obvious but rather must consider what the prior art would have led a person skilled in the art to do." *In re Tomlinson*, 150 USPQ 623 (CCPA 1966).

In *In re Goodwin*, the claimed invention recited a glass mold lubricant and a method of coating a glass mold cavity with a carbon monofluoride. 576 F.2d 375, 198 USPQ 1 (CCPA 1978). The prior art taught the use of carbon monofluorides as cell lubricants. *Id.* On that basis, the PTO asserted it would have been obvious to use carbon monofluorides as mold lubricants, as recited in the claimed invention. *Id.* The Court of Customs and Patent Appeals disagreed, stating there was no teaching to modify the prior art. *Id.* One of skill in the art might fortuitously try to use carbon monofluoride as a mold lubricant, but the prior art provided no teaching or suggestion

to do so. *Id.* Applying *In re Goodwin*, Mahl is cited for teaching a ring seal for a bell jar; however, Mahl provides no teaching or suggestion to use the ring seal as a sound dampening member.

Mahl also fails to teach a sound dampening pad comprising a strip of flexible polymeric material having a finite length, as recited in the claims. The strip may be cut to varying lengths depending on the printing sleeve. *See generally* ¶ [0025]. In contrast, the Mahl seal is a continuous ring, not a strip. Due to its ring structure, the Mahl ring seal has a continuous length with no end portions. Thus, Mahl does not teach a strip having a finite length, and further does not teach a generally curved or a generally curved J-shaped configuration *when viewed from an end thereof*, as recited in claims 1 and 8, respectively.

Furthermore, as shown below in Fig. 2 of Mahl, Mahl does not teach a generally curved J-shaped configuration, as recited in claim 1 or a generally curved configuration, as recited in claim 8.

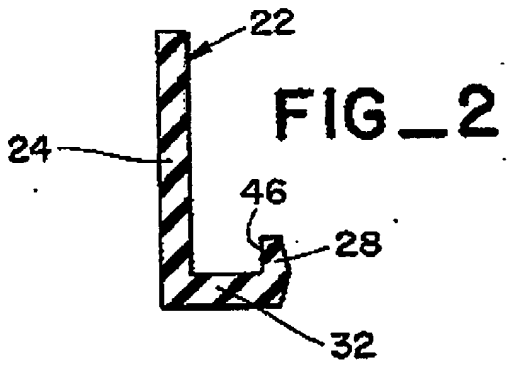


FIG_2

As shown in Fig. 2 of Mahl, the outer leg 24 perpendicularly intersects with the cross member 32, and creates an angled, not curved configuration. The examiner asserts that Mahl's material teaches curves in the sealing arrangement; however, Mahl does not support this assertion. Mahl only teaches configurations with planar surfaces.

Moreover, modifying Mahl's seal to a curved configuration would render Mahl inoperable for its intended purpose. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). As shown above in Fig. 2, the Mahl ring seal is directed to sealing a cylindrical bell jar by fitting the cross member against the planar rim of the jar. (*Summary of the Invention*). If the cross member 32 was modified to have a curved configuration, the curved cross member would not form an effective fit around the planar rim. Without a proper fit around the planar rim, the Mahl ring cannot perform its intended function i.e. sealing a jar. As a result, modifying Mahl, as the examiner proposed, would render Mahl inoperable for its intended purpose. Accordingly, there is no teaching or suggestion to make the proposed modification.

In addition, the examiner, citing *In re Dailey*, errs in stating that a curved configuration is one of numerous obvious shapes one skilled in the art would find suitable for the intended final application. 149 USPQ 47 (CCPA 1966). *In re Dailey*, which no court has cited since it was decided 39 years ago, misstates the obviousness standard by stating that the claimed application makes a claimed shape obvious. *Id.* Applying *In re Dailey* would constitute impermissible hindsight reconstruction, and thereby relieve the examiner of his burden of showing the desirability of the claimed shape or configuration. The proper standard for determining obviousness is stated below in *In re Fritch*:

> The mere fact that prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. It is impermissible to use the claimed invention as an instruction

manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious.

23 USPQ2d 1780, 1783-4 (Fed. Cir. 1991).

In addition, there is no motivation to combine the teachings of Mahl and Caldwell. Mahl teaches an elastomeric ring seal directed to sealing a bell jar. Caldwell teaches vibration damping structures used in airplane fuselage panels, motor vehicle bodies, or household appliances. The examiner states that one skilled in the art would know to combine the adhesive of Caldwell with the Mahl sealing jar, because of the ready-to-lay convenience of the adhesive. As a threshold, neither reference teaches or suggests sound dampening. Additionally, there is no motivation or suggestion in the art that combining a bell jar seal and a vehicle vibration damping structure should be combined to form a *sound* dampening pad typically used in a printing sleeve. Ready to lay convenience is a very general teaching, which would not lead one skilled in the art to combine Mahl and Caldwell. Rather, the vibration damping material of Caldwell is not pertinent to Mahl as Mahl is directed to sealing a bell jar. There is absolutely no evidence that Mahl had a problem with vibrations, which would have led him to Caldwell. Thus, there is no motive or suggestion to combine the Mahl and Caldwell references

Even if the Mahl and Caldwell references were combined through impermissible hindsight reconstruction, the combination still fails to teach all elements of the claimed invention. The combination fails to teach a strip of finite length having a curved configuration. Mahl has a continuous ring with angular legs; Caldwell has neither. Accordingly, the cited references fail to teach or suggest all elements of the claimed invention. Thus, independent claims 1 and 8 and all claims dependent thereon are in condition for allowance. Applicants respectfully submit that the application is now in condition for allowance. The Examiner is

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encouraged to contact the undersigned to resolve efficiently any formal matters or to discuss any aspects of the application or of this response. Otherwise, early notification of allowable subject matter is respectfully requested.

Respectfully submitted,

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